

## REMARKS

Claims 173-190 are now pending in the application. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the remarks contained herein.

Should the Examiner rely on a new ground of rejection or a new reference in rejecting the claims in the next Office Action, a Final Office Action would not be appropriate since no amendments have been made to the claims. See MPEP § 706.07(a) – under present practice, Office Actions where the Examiner introduces a new ground of rejection shall be final only when the new ground of rejection is necessitated by Applicant's amendment of the claims.

## REJECTION UNDER 35 U.S.C. § 103

Claims 173-175, 178, 182-184, and 187 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 6,332,175 ("Birrell") in view of U.S. Pat. No. 6,233,393 ("Yanagihara"). Claims 173, 174, 182, and 183 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 7,444,439 ("Du") in view of Yanagihara. These rejections are respectfully traversed.

Claim 173 recites that the programmable processor determines a compression format of the compressed media data after the compressed media data is retrieved from the storage

device, retrieves a selected one of the plurality of processes in response to determining the compression format, and decompresses the compressed media data based on the selected one of the plurality of processes. Claim 173 further recites a storage device to store compressed media data and a plurality of processes that decompress the compressed media data.

*A. Birrell and Du do not show, teach, or suggest that the programmable processor determines a compression format of the compressed media data after the compressed media data is retrieved from the storage device, retrieves a selected one of the plurality of processes in response to determining the compression format, and decompresses the compressed media data based on the selected one of the plurality of processes.*

The Examiner acknowledges that Birrell and Du do not disclose that the programmable processor is configured to determine the compression format, select a first process of the plurality of processes, and decompress the compressed media based on the first process. (See Pages 4 and 12 of the Office Action). Instead, the Examiner relies on Yanagihara to make up for the deficiencies of Birrell and Du.

Further, the Examiner acknowledges that Birrell and Du do not disclose a plurality of processes, and instead takes official notice that "a number of compression standards were available." (See Pages 4 and 11 of the Office Action). Applicant respectfully disagrees that a media device including a

storage device to store a plurality of processes would be obvious merely because "a number of compression standards were available."

For example, the Examiner merely states that "it would be desirable to have a single device...rather than purchase a number of devices."

This brief explanation falls far short of the type of explicit analysis that is required by the Supreme Court in KSR Int'l v. Teleflex Inc., 127 S.Ct. 1727 (2007). Absent such an express teaching or suggestion in the references, the explicit analysis and reasoning must be supplied by the Examiner. *Id.* In other words, the Examiner is required to provide explicit reasoning as to why one skilled in the art would be motivated to construct a media device including a storage device to store a plurality of processes, each of the plurality of processes configured to decompress compressed media data.

Here, the Examiner merely notes that "it would be desirable to have a single device for decompression." The Examiner fails to provide explicit analysis and reasoning for why one skilled in the art would arrive at the specific solution (i.e. storing a plurality of processes and selecting one of the processes according to specific criteria) provided by Applicant's invention as required.

Further, while Applicant recognizes that the Examiner is entitled to support a rejection based on common knowledge in the art, Applicant respectfully submits that the Examiner can only take official notice of facts outside of the record which are capable of instant and unquestionable demonstration of being "well-known" in the art. See, MPEP § 2144.03, In re Knapp Monach Co., 132 USPQ 340, 341 (CCPA 1973).

If the Examiner is basing the rejection on personal facts known to the Examiner, Applicant respectfully requests that the Examiner provide an affidavit to support those facts. See MPEP 2144.03; 37 CFR 1.104(d)(2). Alternatively, Applicant respectfully requests that a reference be provided to support an assertion that a media device including a storage device to store a plurality of processes, each of the plurality of processes configured to decompress compressed media data, is within the common knowledge of skilled artisans. Here Birrell does not include this limitation. Therefore, Applicant respectfully submit that Birrell and Du fall short of the aforementioned "unquestionable demonstration" that is required.

B. Yanagihara does not show, teach, or suggest the programmable processor determines a compression format of the compressed media data after the compressed media data is retrieved from the storage device, retrieves a selected one of the plurality of processes in response to determining the compression format, and decompresses the compressed media data based on the selected one of the plurality of processes.

The Examiner alleges that Yanagihara discloses "a device with a general controller that determines the compression of audio data and set the decoder to decompress the given compression," citing FIG. 15 of Yanagihara. (See Page 5 of the Office Action). Applicant respectfully submits that FIG. 15 and the corresponding description are not analogous to the limitations that claim 173 recites.

For example, Applicant respectfully notes that Yanagihara states that "[t]he general controller section 21 may set a decoder, or a parameter(s) pertaining thereto, in the presentation engine 12 in accordance with the received control data." (Col. 2, lines 10-13). The general control data is received from a DVD 101. (Col. 2, lines 5-6). Yanagihara discloses that the control data is received along with the encoded media data from the same source (i.e. the DVD 101). The general controller section 21 sets decoder parameters based on the general control data. Consequently, Yanagihara discloses, at best, receiving encoded media data and general control data,

and decoding the encoded media data in accordance with the general control data. Yanagihara is completely absent of any teaching or suggestion of determining a compression format of the compressed media data after the compressed media data is retrieved from the storage device and retrieving a selected one of the plurality of processes in response to determining the compression format.

Accordingly, Yanagihara discloses receiving control data along with the compressed media data, not determining the compression format of the compressed media data. Further, Yanagihara discloses setting decoder parameters based on the received control data, not selecting a particular process of a plurality of processes and retrieving the process from a storage device.

*C. Claim 173 has limitations not taught by either reference.*

It is a longstanding rule that to establish a *prima facie* case of obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 143 (CCPA 1974). See MPEP § 2143.03. For at least the above reasons, Applicant respectfully asserts that claim 173 defines over the cited art.

*D. Other Claims*

Independent claim 182 is allowable for at least similar reasons as claim 173.

*E. Dependent Claims*

Applicant respectfully notes that claims 174-181 and 183-190 depend directly or indirectly from claims 173 and 182 and therefore are allowable for at least similar reasons as claims 173 and 182. Applicant's position with respect to claims 174-181 and 183-190 should not be understood as implying that no other reasons for the patentability of claims 174-181 and 183-190 exist. Applicant reserves the right to address these other reasons at a later date if needed.

*F. Other Rejections*

Claims 179-181 and 188-190 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Birrell in view of Yanagihara in further view of U.S. Pat. No. 5,903,871 ("Terui"). Claims 175-177 and 184-186 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Du in view of Yanagihara and in further view of U.S. Pat. No. 6,502,194 ("Berman"). These rejections are respectfully traversed.

Terui, Du, and Berman do not remedy the deficiencies of Birrell and Yanagihara with respect to claims 173 and 182. Claims 175-177, 179-181, 184-186, and 188-190 ultimately depend

from claims 173 and 182 and therefore are in condition for allowance for at least similar reasons. Applicant's position with respect to claims 175-177, 179-181, 184-186, and 188-190 should not be understood as implying that no other reasons for the patentability of claims 175-177, 179-181, 184-186, and 188-190 exist. Applicant reserves the right to address these other reasons at a later date if needed.

Further, claim 175 recites that the programmable processor transfers first portions of at least one of the plurality of media selections from the storage device to the memory, the output device outputs the first portions from the media device, a user selects a particular one of the plurality of media selections in response to the first portions, and the programmable processor retrieves a remaining portion of the particular one of the plurality of media selections in response to the user selection.

In other words, (i) the programmable processor transfers the first portions, (ii) the output device outputs the first portions, (iii) the user selects one of the media selections **in response to the first portions**, and (iv) the programmable processor retrieves the remaining portion **in response to the user selection**.

The Examiner acknowledges that Du fails to disclose these limitations and instead relies on Berman to make up for the

deficiencies of Du. Applicant respectfully submits the Berman fails to disclose that the user selects one of the media selections in response to the first portions, and the programmable processor retrieves the remaining portion in response to the user selection.

Instead, Berman discloses portions of songs are initially downloaded in response to user selection. (See Column 11, Line 65 through Column 12, Line 5). Specifically, the user selects songs 1, 2, and 3, and then "once a sizeable amount of compressed audio information is stored for that song, the playback unit begins to process the information and play the song." (See Column 12, Lines 1-4). In other words, the user selects a song before the first portions are transferred. In contrast, claim 175 recites that the user selects one of the media selections **in response to the first portions**. Then, after the selection, the programmable processor retrieves the remaining portion **in response to the user selection**. As such, Applicant respectfully submits that the structure of Berman is in direct contradiction to these limitations.

Claim 184 is allowable for at least similar reasons as claim 175.

**DOUBLE PATENTING**

Claims 173, 174, 182, and 183 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 7, and 8 of U.S. Patent No. 7,546,172. Claims 173, 174, 182, and 183 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 7, and 8 of U.S. Patent No. 7,457,676. Claims 173, 174, 182, and 183 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 7, and 8 of U.S. Patent No. 7,315,764. Applicant includes herewith timely filed terminal disclaimers in compliance with 37 C.F.R. § 1.321 to overcome the nonstatutory double patenting rejections.

CONCLUSION

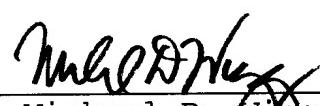
It is believed that all of the stated grounds of rejection have been properly addressed. For all of the reasons set forth above, Applicant submits that the application is in condition for allowance. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. By addressing particular positions taken by the Examiner in the above remarks, Applicant does not acquiesce to other positions that have not been explicitly addressed. In addition, Applicant's arguments for the patentability of a claim should not be understood as implying that no other reasons for the patentability of that claim exist.

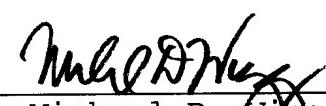
If the Examiner believes that personal communication will allow any outstanding issues to be resolved, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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By:

  
Michael D. Wiggins  
Reg. No. 34,54

  
Damian M. Aquino  
Reg. No. 54,964

HARNESS, DICKEY & PIERCE, P.L.C.  
P.O. Box 828  
Bloomfield Hills, Michigan 48303  
(248) 641-1600

MDW/DMA/rao